Amendments to the Drawings:

The attached sheet of drawings includes changes to FIG. 6. This sheet replaces the original sheet. Elements 53_1n, 54_1n, 55_1n and 56_1n, as described in paragraph [0035] of the application, have been added. Attached herewith and labeled appropriately at the top of each sheet are the Replacement Sheet and Annotated Sheet Showing Changes.

REMARKS

Claims 1-7 are pending in the application.

Claims 1-3, 6 and 7 stand rejected, and claims 4 and 5 are allowed. Acknowledgement as to the proper status of the claims on the Office Action Summary is respectfully requested.

Claim 3 has been clarified herein to ensure that it is not a 112, six paragraph claim.

In addition, Applicant respectfully requests an acknowledgement of a claim for foreign priority and receipt of a certified copy of the priority document.

In response to the Office Action, Applicant attaches a replacement sheet of drawings that includes changes to FIG. 6. This sheet replaces the original sheet. Elements 53_1n, 54_1n, 55_1n and 56_1n, described in paragraph [0035] of the application, have been added to correct an omission as correctly pointed out in the Office Action. Attached herewith and marked with an appropriate label at the top of each sheet are the Replacement Sheet and Annotated Sheet Showing Changes. Withdrawal of the objection to the drawings is respectfully requested.

Further in response to the Office Action, the disclosure has been amended to correct a minor error. Paragraph [0036] has been amended to correspond to the description therein, paragraph [0035] and FIG. 6. Withdrawal of the objection to the specification is respectfully requested.

REJECTIONS UNDER 35 U.S.C. 103

Claims 1-3 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent 4,398,063 (Hass et al). In addition, claim 7 is rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent Application Publication US2001/0036164 (Kakemizu et al.) Applicant respectfully traverses the rejections for the following reasons.

Hass is directed to mobile communications systems. In particular, Hass discloses a handoff between an old serving MTSO and a new serving (target) MTSO. A so-called drop-back takes place, such that an old serving MTSO arranges for the disconnection of any trunk circuits which are not necessary to the continuation of the call connection under the control of the new serving MTSO.

In contrast to Hass, the present invention is directed to "a communication device which releases, with a movement of a single mobile node to be managed, an older tunnel already established ..." as recited in Applicant's claim 1. It is submitted that Applicant's tunnel does not correspond to Hass' trunk. According to Applicant's specification, a number of tunnels are typically established as a mobile node moves from one router to another router, and these tunnels are typically **not released**. As stated in Applicant's specification and shown in FIG. 1, "the reason why a plurality of tunnels 71-74 are established in this way **without releasing a previous tunnel** is to avoid such a case that when the tunnel 73 is released immediately after the establishment of the tunnel 74 and the mobile node 300 returns from the router 203 to the router 202, a resource can not be secured so that the tunnel 73 can not be established" (emphasis added). See paragraph [0010] on page 3 of the application. A trunk, on the other hand, is merely a line between 2 MTSOs, and the trunks are not maintained as the mobile unit travels from one area serviced by one MTSO to a second area serviced by a second MTSO because handoff takes place, as disclosed in Hass.

It is respectfully submitted that Hass could not possibly describe "tunneling" as that technology was not known to skilled artisans at the time that the Hass application was filed.

Furthermore, it is conceded in the Office Action that Hass fails to teach or suggest Applicant's feature of "to prevent a number of all tunnels ... from exceeding a predetermined

threshold value" as recited in claim 1. However, according to the Office Action, "it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to modify the method of Hass ('063) by adding a predetermined threshold value for the allowable number of trunks (tunnels) because the modification will prevent system resources from overloading during design and implementation."

In reply, it is respectfully submitted that a prima facie case of obviousness has not been established in this case. "For a prima facie case of obviousness to exist, there must be some objective teaching in the prior art or ... knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases the nature of the problem to be solved." In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

Analyzing the current application according to the Federal Circuit's roadmap as outlined above, in the Office Action under reply there are no other prior art references to turn to for motivation, suggestion or teaching. Therefore, the knowledge of ordinary skill in the art is used to provide the requisite motivation, suggestion or teaching for the above-mentioned feature of Applicant's claim 1. However, it is respectfully submitted that the "skilled artisan" standard has been applied improperly.

No source of information was identified from which to base its argument on one having an ordinary skill in the art. Therefore, it appears that the Examiner uses his own knowledge as a skilled artisan. Such generalized statement, however, fails to satisfy the level of specificity that is required. "Particular findings must be made as to the reason the skilled artisan, with no

knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 1371. The MPEP provides guidelines for relying on official notice and personal knowledge, which were not followed in this case:

> The rationale supporting an obviousness rejection may be based on common knowledge in the art of "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art ...
> When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

See MPEP §2144.03. The conclusory statement and convenient assumption about skilled artisan according to the Office Action are inadequate to support a finding of motivation under either the binding case law or MPEP. If the Examiner disagrees, an affidavit is respectfully requested per MPEP §2144.03.

In light of the above, it is respectfully submitted that claim 1 is not rendered obvious by Hass. Withdrawal of the rejection is warranted.

With respect to Applicant's claim 2, there is no indication of a unique number of trunks in Figures 6-8 of Hass corresponding to Applicant's threshold value, contrary to the Office Action. In addition, as dependent claim 2 depends from independent claim 1, Applicant submits that this dependent claim is also allowable for at least the reasons stated hereinabove with reference to claim 1.

Applicant essentially repeats the above arguments with respect to independent claim 3 to submit that it is not unpatentable over Hass. Since claim 3 is not rendered obvious by Hass, withdrawal of the rejection is respectfully requested.

With respect to claim 7, it is submitted that Kakemizu can't be used against Applicant's invention under 35 U.S.C. 103. According to the Office Action, the rejection is applied under Section 103 through Section 102(e). However, Kakemizu and the present invention are commonly owned, and according to 35 U.S.C. 103(c), "effective November 29, 1999, 35 U.S.C. 103(c) provides that subject matter developed by another which qualifies as 'prior art' only under one or more of subsections 35 U.S.C. 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made." Therefore, withdrawal of the rejection is requested.

REJECTION UNDER 35 U.S.C. 102

Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Kakemizu. Applicant respectfully traverses the rejection for the following reasons.

Kakemizu fails to teach "a communication device which determines a lifetime ... **based on a number of all tunnels presently used by the communication device**" (emphasis added). Contrary to the Office Action, paragraphs [0215] through [0219] in Kakemizu does not disclose the above-emphasized limitation of claim 6. Since to anticipate a claim, the reference must teach every element of the claim (see MPEP 2131), withdrawal of the rejection based on Kakemizu is warranted.

CONCLUSION

An earnest effort has been made to be fully responsive to the Examiner's communication. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance. Passage of this application to allowance is earnestly solicited. However, if for any reason this application is not considered to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

We respectfully request that all fees relating to this application be charged to Deposit Acct. No. 50-1290.

Respectfully submitted,

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